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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/501,315	02/09/2006	Ban Chin To	105SR-019	6117
32192	7590	10/05/2007		
BRADLEY N. RUBEN, PC 463 FIRST ST, SUITE 5A HOBOKEN, NJ 07030			EXAMINER MAKIYA, DAVID J	
			ART UNIT	PAPER NUMBER
			2885	
			MAIL DATE	DELIVERY MODE
			10/05/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/501,315

Applicant(s)

TO, BAN CHIN

Examiner

David J. Makiya

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 July 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 34-58 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 34-58 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 July 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Objections

Claims 37-40 and 45-48 are objected to because of the following informalities: it is unclear if the applicant is referring to a "non-circular section" to be a "non-circular cross section." The claims will be interpreted as best understood.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 34-36, 41-44, 49-51, and 56-58 are rejected under 35 U.S.C. 102(b) as being anticipated by Birk et al. (US Patent 5,404,297).

With respect to claim 34, Birk et al. teaches a light fitting having a support surround (14, 40) and a front facia 56, and a facia retainer 70 for holding the facia in position, the facia retainer being resilient for enabling removal of the facia from an installed position thereof by a generally translational movement (Figure 8), the light fitting further having a lamp retainer 60 and a lamp 92 wherein the lamp is retained by the lamp retainer, the lamp being resiliently biased toward the facia such that the lamp may be moved away from the facia against the resilient bias to provide access behind the facia to facilitate removal of the facia (Figure 9).

With respect to claim 35, Birk et al. teaches the light fitting in which the lamp retainer forms the front facia (Figure 5).

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With respect to claim 36, Birk et al. teaches the light fitting in which the lamp retainer comprises a tube extending axially in front of the lamp (Figure 5).

With respect to claim 41, Birk et al. teaches the light fitting in which the support surround includes at least one spring arm 50 for holding the light fitting in place on a layer of building material.

With respect to claim 42, Birk et al. teaches the light fitting in which the front facia is directly retained by the facia retainer to the support surround (Figure 6).

With respect to claim 43, Birk et al. teaches the light fitting in which the front facia is attached by the facia retainer to an intermediate member 14, the intermediate member being connected to the support surround.

With respect to claim 44, Birk et al. teaches the light fitting in which the intermediate member is pivotally coupled to the support surround (Figure 1).

With respect to claim 49, Birk et al. teaches the light fitting in which the facia retainer comprises at least one spring clip 70.

With respect to claim 50, Birk et al. teaches the light fitting in which a pair of said spring clips is provided, located on opposed sides of the light fitting (Figure 5).

With respect to claim 51, Birk et al. teaches the light fitting in which each spring clip is secured to the front facia (Figure 6).

With respect to claim 56, Birk et al. teaches the light fitting in which the facia includes a recessed ledge 84 for engaging the perimeter of a lamp.

With respect to claim 57, Birk et al. teaches the light fitting which includes a lamp 92, the lamp having a flat front surface (Figure 5).

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With respect to claim 58, Birk et al. teaches the light fitting which comprises a downlighter (Figure 1).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 37-40 and 45-48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Birk et al.

With respect to claims 37-40 and 45-48, Birk et al. teaches the light fitting as described above. However, Birk et al. fails to teach a particular shape for the front facia or intermediate member to have a non-circular cross section. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the cross sectional shape of the front facia or intermediate member to be non-circular such as hexagonal or square, since it has been held by the courts that a change in shape or configuration, without any criticality, is nothing more than one of numerous shapes that one of ordinary skill in the art will find obvious to provide based on the suitability for the intended final application *In re Dailey*, 149 USPQ 47 (CCPA 1976) and *KSR International Co. v. Teleflex Inc.*, 550 U.S. -, 82 USPQ2d 1385. It appears that the disclosed device would perform equally well shaped as disclosed by Birk et al.

Claims 52-55 are rejected under 35 U.S.C. 103(a) as being unpatentable over Birk et al. in view of Winkelhake (US Patent 5,597,234).

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With respect to claims 52-55, Birk et al. teaches the light fitting with resilient biasing for biasing the lamp towards the front facia as described above. However, Birk et al. fails to teach the resilient biasing for biasing the lamp towards the front facia is provided by a spring.

Winkelhake teaches a light fitting comprising a front facia 71 with a lamp 17 and a resilient biasing for biasing the lamp towards the front facia is provided by a helical spring 118 in which two said springs are provided (Figure 5), each extending from an end of the lamp opposite a lens end thereof to the lamp retainer (Figure 5) and in which each spring extends from an electrical connector 126 to the lamp retainer (Column 6, Lines 11-28). It would have been obvious to one of ordinary skill in the art at the time of the invention to replace the resilient biasing of Birk et al. with the helical springs from Winkelhake because "engagement of said spring with said groove provides an axial restraint while engagement by said complimentary element in said aperture provides a rotational restraint as well as giving said spring a positive orientation" (Winkelhake; Column 2, Lines 6-14).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Gromotka (US Patent 6,164,802) and Doubeck et al. (US Patent 5,951,151) teach light fittings with resilient retainers.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to David J. Makiya whose telephone number is (571) 272-2273. The examiner can normally be reached on Monday-Friday 7:30am - 4:00pm (ET).

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jong (James) Lee can be reached on (571) 272-7044. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

DJM 09/25/2007



JOHN ANTHONY WARD
PRIMARY EXAMINER